The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLAIM RUSSELL BELKNAP
and STEVEN VICTOR KAUFFMAN

Appeal No. 2007-0264
Application 09/986,248
Technology Center 2100

Decided: February 22, 2007

Before JAMES D. THOMAS, MAHSHID D. SAADAT, and JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal from the Examiner's final rejection of claims 1 through 10, 13 through 23, 25 through 29, 31 and 32 pursuant to 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal.

We held an oral hearing in this appeal on February 8, 2007.

The Examiner rejects claims 1 through 21 as follows:

A. Claims 1 through 3, 13 through 15, 25 and 26 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Halpern.

B. Claims 4, 5, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Halpern.

C. Claims 6 through 10, 18 through 23, 27 through 29, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Halpern and Feinman.

The Examiner relies on the following references:

Feinman	6,075,943	Jun. 13, 2000
Halpern	6,282,711	Aug. 28, 2001

Independent claim 1 is illustrative and representative of the Appellants' invention. It reads as follows:

1. A method of requesting and processing a plurality of objects from a server, comprising:

requesting a plurality of objects from the server;

receiving a response message from the server, the response message containing the plurality of objects packed into the response message; and

automatically unpacking the plurality of objects contained in the response message.

First, Appellants contend that Halpern does not anticipate claims 1 through 3, 13 through 15, 25 and 26. Particularly, Appellants contend that Halpern does not fairly teach or suggest automatically unpacking a plurality of objects in a response message. (Br. 14-15; Reply Br. 5). Second, Appellants contend that claims 4 through 10, 16 through 23, 27 through 29, 31 and 32 would not have been obvious over Halpern alone or in combination with Feinman.[1] Particularly, Appellants contend that Halpern does not teach a packet request. (Br. 16). Further, Appellants contend that the combination of Halpern and Feinman does not teach outputting or presenting unpacked objects in the order indicated in the response message. Therefore, Halpern alone or in combination with Feinman would not have rendered claims 4 through 10, 16 through 23, 27 through 29, 31 and 32 unpatentable. (Br. 19-20).

The Examiner contends that Halpern's batch processing of a self-extracting executable file received at the client computer corresponds to

---

1 This decision considers only those arguments that Appellants submitted in the Appeal and Reply Briefs. Arguments that Appellants could have made but chose not to make in the Briefs are deemed to have been waived. *See* 37 CFR 41.37(c)(1) (vii)(eff. Sept. 13, 2004). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

Appellants' automatic unpacking of objects in a response message, as claimed. (Answer 4). The Examiner also contends that Halpern's packetization transport protocol allows the packing of objects from the server to the client and vice-versa. (Answer 6). Further, the Examiner contends that Feinman's sequential file teaches presenting packed objects in an indicated order. (Answer). The Examiner therefore concludes that it would have been obvious to one of ordinary skill in the art to yield the claimed invention based on Halpern alone, or in combination with Feinman.

We affirm.

ISSUES

The *pivotal* issues on appeal before us are as follows:

(1) Under 35 U.S.C. § 102(e), does Halpern's disclosure anticipate the claimed invention when Halpern teaches that the client processes in batch mode a self-extracting executable file received from the server in response to a client request?

(2) Under 35 U.S.C. § 103(a), would one of ordinary skill in the art, at the time of the present invention, have found Halpern alone or in combination with Feinman renders the claimed invention unpatentable when Halpern

teaches a packetization transport protocol and Feinman teaches transferring a sequential file containing a plurality of objects?

FINDINGS OF FACT

Appellants invented a method, apparatus and a computer-readable medium for packing and unpacking objects in an electronic message to facilitate the request and transfer of the objects between a client and a server. (Specification 5). Particularly, the server (4) receives a message from the client (1) requesting a plurality of objects. The server (4) searches a plurality of object databases (9a, 9b, 9c) from which it retrieves the requested objects. The server (4) then sends to the client the retrieved objects packed in the response message. Upon reaching the client (1), the packed objects are automatically unpacked in the order indicated in the response message. (Specification 7).

Halpern discloses a method for allowing a client user to select from a remote server location desired software components that the server delivers to the client in a single download and as a single file. (Abstract). As depicted in figure 1, Halpen teaches that the server, upon retrieving the requested software components from a database (108) and pool components (107), the installer set generator (109) bundles them into a custom

installation file. (col. 6, lines 1-6). The installer set generator (109) then forwards the custom installation file to the packager (110), which transforms the file into a custom installation package. (col. 6, ll. 6-10). The packager (110) transforms the custom installation package into a self- extracting executable file by submitting the package to a compression process (111), and then to a self-extractor process (112). The self-extracting executable file is subsequently delivered to the client as a single file via a packetization transport protocol. (col. 6, ll. 14-22). Halpern further teaches that the packager (110) interfaces with a batch mode application (115) residing on the client computer to install application programs (e. g. retrieved software components) from the component tool (107) *without any interaction* between the user and the option manager (104). (col. 6, ll. 29-43).

Feinman teaches a method and system for remotely transferring application programs from a remote server and automatically installing them on a client computer via a network. (col.2, lines 34-36). Feinman also teaches packaging a plurality of application programs into a compressed file that records all subdirectories of the application programs. The compressed file is transmitted to the client along with a sequential file containing delivery information such that decompression of the application program at

the client computer recreates the exact directory structure (col.2, lines 38-45).

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Id.*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Id.*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion.

ANALYSIS

1. ANTICIPATION

The Examiner properly found that Halpern anticipates the claimed invention. We find that Halpern's packager, when used in the batch processing mode in collaboration with the client system, will automatically run the self-extracting executable file to unpack and decompress the software components that the client had selected. Such a finding is reasonable since when the packager is operating in the batch mode, it delivers the self-extractable executable file in the client without any user intervention (i.e. "automatically"). After considering the entire record before us, we find that the Examiner did not err in rejecting claims 1 and 2 over Halpern. We also find that the Examiner did not err in rejecting claims 3, 13 through 15, 25 and 26 over Halpern.

2. OBVIOUSNESS

The Examiner properly found that Halpern's teaching of packing a plurality objects in a single message for transferring a packed response from a server to a client via a packetization protocol would lead one of ordinary skill in the art to send a packed request from the client to the server. The ordinarily skilled artisan would have readily recognized that transferring a packed message results in greater efficiency than sending the objects

individually. Thus, the packed message approach, as taught by Halpern, would allow selected software components at the client to all be received at the server at the same time, and without delay.

Further, the Examiner properly found that the combination of Halpern and Feinman would lead one of ordinary skill in the art to output or display the unpacked objects in a specified order. The ordinarily skilled artisan would have readily recognized, as taught by Feinman, as objects in a received message are sequentially being unpacked and decompressed, the client would save time by immediately processing and displaying them in the order that they appear in the message.

After considering the entire record before us, we find that the Examiner did not err in rejecting claims 4 through 10, 16 through 23, 27 through 29, 31 and 32 over the combination of Halpern taken alone or in combination with Feinman.

CONCLUSION OF LAW

On the record before us, Halpern's disclosure anticipates the claimed invention under 35 U.S.C. § 102 (e) when Halpern teaches that the client processes in batch mode a self-extracting executable file received from the server in response to a request. Further, one of ordinary skill in the art at the

time of the present invention, have found Halpern, alone or in combination with Feinman, renders the claimed invention unpatentable under 35 U.S.C. § 103(a) when Halpern teaches a packetization transport protocol and Feinman teaches transferring a sequential file containing a plurality of objects.

DECISION

We affirm the Examiner's decision to reject claims 1 through 3, 13 through 15, 25 and 26 under 35 U.S.C. § 102(e) as being anticipated by Halpern. We also affirm the Examiner's decision to reject claims 4, 5, 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Halpern. Additionally, we affirm the Examiner's decision to reject claims 6 through 10, 18 through 23, 27 through 29, 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Halpern and Feinman.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

kis

SUGHRUE & MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037